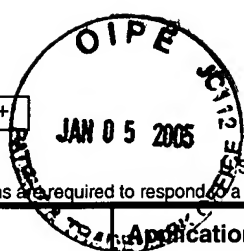


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PTO/SB/21 (08-00)

Approved for use through 10/31/2002. OMB 0651-0031

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TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	10/040,231
Filing Date	January 2, 2002
First Named Inventor	STERN, Edith H.
Group Art Unit	2632
Examiner Name	Nguyen, Phung
IBM Docket Number	YOR9200100483US1

Total Number of Pages in This Submission

58

ENCLOSURES (check all that apply)

<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Assignment Papers (for an Application)	<input type="checkbox"/> After Allowance Communication to Group
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Amendment / Reply	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input checked="" type="checkbox"/> Petition Under 37 C.F.R. §1.181(a) to Withdraw Holding of Abandonment	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Declaration and Power of Attorney – 8 pages in total	<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Copy of Amendment and Response to May 5, 2004 Office Action, copy of date-stamped Postcard, copy of Patent Application Information Retrieval off PAIR, copy of date-stamped Amendment and Response to May 5, 2004 Office Action, and Acknowledgement Postcard
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Terminal Disclaimer	
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> Request for Refund	
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> CD, Number of CD(s)	
<input type="checkbox"/> Response to Missing Parts/ Incomplete Application	Remarks	
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Patrick J. Buckley
Signature	<i>Patrick Buckley</i>
Date	January 3, 2005

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450:		January 3, 2005
Type or printed name	Edith Martin	
Signature	<i>Edith Martin</i>	Date January 3, 2005

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.



Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: STERN et al.

Application No.: 10/040,231

Filing Date: January 2, 2002

For: SYSTEMS, METHODS, AND
APPARATUS FOR MONITORING
A CONTAINER ASSOCIATED
WITH AN ITEM

) Group Art Unit: 2632

) Examiner: Nguyen, Phung

) **Petition Under 37 CFR §1.181(a) to
Withdraw Holding of Abandonment**

) **IBM Docket No.: YOR920010483US1**
) (Attorney Docket No.: I01.060)

) Buckley, Maschoff & Talwalkar LLC
) Five Elm Street
) New Canaan, CT 06840
) (203) 972-0006

CERTIFICATE OF MAILING UNDER 37 CFR 1.8

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Dated: January 3, 2005

By:

Edith Martin
Edith Martin

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**PETITION UNDER 37 CFR §1.181(A) TO WITHDRAW HOLDING OF
ABANDONMENT**

Sir:

A Notice of Abandonment has been received in the above-identified application. Applicants respectfully request that the Notice of Abandonment be withdrawn in view of the following facts.

(1) The US PTO mailed a non-final Office Action in connection with this application on May 5, 2004. A three-month shortened statutory period for reply was set to expire three months from the mailing date (*i.e.*, to expire on August 5, 2004).

(2) Attachment A is a copy of a Response Transmittal and Amendment that were mailed to the US PTO on July 20, 2004. Each include an executed Certificate of Mailing under 37 CFR 1.8 dated July 20, 2004. No fee was associated with the Amendment.

(3) Attachment B is a copy of an Acknowledgement Postcard including a stamp that indicates the Response Transmittal and Amendment were received by the US PTO on July 22, 2004.

(4) Attachment C is a print-out of the Patent Application Information Retrieval (PAIR) File History for this application that includes a contents description of "workflow incoming amendment IFW" on July 22, 2004.

(5) Attachment D is a print-out from the PAIR Image File Wrapper for this application indicating that the following documents have a "mail room date" of July 22, 2004:

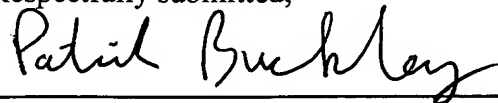
Applicant Arguments or Remarks Made in an Amendment (page count 10);
Claim (page count 9); and
Amendment (page count 3).

(6) Attachment E is a print-out of the above three documents downloaded from the PAIR Image File Wrapper system in pdf format. Applicants note that cover pages of the Response Transmittal and Amendment included in these documents indicate they were both "Received July 23 2004 Technology Center 2600."

In view of these facts, Applicants respectfully request that the Notice of Abandonment be withdrawn. Please contact the undersigned for any clarification or further information required in support of this Petition. Applicants believe that no fee is required in connection with this Petition, but the Commissioner is hereby authorized to charge any fee associated with this Petition to Deposit Account No. 50-0510.

January 3, 2005
Date

Respectfully submitted,



Patrick J. Buckley
Registration No. 40,928
Buckley, Maschoff & Talwalkar LLC
Five Elm Street
New Canaan, CT 06840
(203) 972-0191



Date: 07/20/2004
37 C.F.R. § 1.8

Title: **SYSTEMS, METHODS, AND APPARATUS FOR MONITORING A CONTAINER
ASSOCIATED WITH AN ITEM**

Inventors: Stern et al.

Enclosed herewith are:

- ☒ Amendment and Response to Non-Final Office Action.
☒ Response Transmittal.
☐ Other (specify): _____

IBM Docket No.: YOR920010483US1

Serial No.: 10/040,231

Filing Date: 01/02/2002

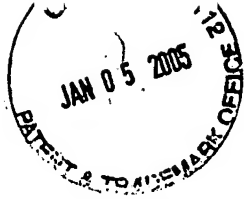
101.060

COPY



BUCKLEY, MASCHOFF & TALWALKAR LLC
Five Elm Street
New Canaan, CT 06840

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Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: STERN et al.

Application Serial No.: 10/040,231

Filing Date: January 2, 2002

For: SYSTEMS, METHODS, AND
APPARATUS FOR MONITORING
A CONTAINER ASSOCIATED
WITH AN ITEM

)
)
) Group Art Unit: 2632

)
) Examiner: Nguyen, Phung

)
) Response Transmittal

)
) IBM Docket No. YOR920010483US1
) (Attorney Docket No.: I01.060)

)
) Buckley, Maschoff & Talwalkar LLC
) Five Elm Street
) New Canaan, CT 06840
) (203) 972-0006
)

CERTIFICATE OF MAILING UNDER 37 CFR 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on July 20, 2004.

Dated: July 20, 2004

By: Edith Martin

Edith Martin

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith for filing are:

1. ☒ Amendment/Response
2. ☒ Additional Enclosures: Acknowledgement Postcard

COPY

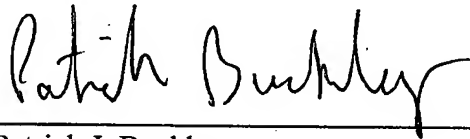
FEE CALCULATION

For	Current	Prev. Paid	No. Extra	Rate	Fee
Total Claims	47	- 51	0	\$ 18.00	\$ 0.00
Indep. Claims	10	- 12	0	\$ 86.00	\$ 0.00
Multiple Dependent Claims (If applicable, please add \$ 290.00)					\$ 0.00
No Petition for Extension of Time is Required					\$ 0.00
OTHER FEE (specify purpose):					\$ 0.00
TOTAL FILING FEE					\$ 0.00

The Commissioner is hereby authorized to charge and credit Deposit Account No. 50-0510 as described below. A duplicate copy of this sheet is enclosed.

- ☒ Credit any overpayment.
- ☒ Charge any additional fees required under 37 CFR 1.17.

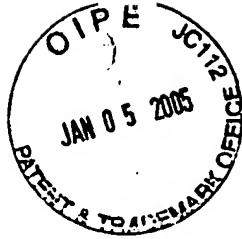
Respectfully submitted,



Patrick J. Buckley
Registration No. 40,928
Attorney for IBM Corporation
Buckley, Maschoff & Talwalkar LLC
Five Elm Street
New Canaan, CT 06840
(203) 972-0191

July 20, 2004
Date

COPY



Application Serial No.: 10/040,231
Amendment and Response to May 5, 2004 Office Action

Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: STERN et al.

Application Serial No.: 10/040,231

Filing Date: January 2, 2002

For: SYSTEMS, METHODS, AND
APPARATUS FOR MONITORING
A CONTAINER ASSOCIATED
WITH AN ITEM

)
) Group Art Unit: 2632
)

) Examiner: Nguyen, Phung
)

) **AMENDMENT and RESPONSE** to May
) 5, 2004 Non-Final Office Action
)

) **IBM Docket No.: YOR920010483US1**
) (Attorney Docket No.: I01.060)
)

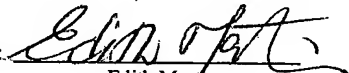
) Buckley, Maschoff & Talwalkar LLC
) Five Elm Street
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) (203) 972-0006
)

CERTIFICATE OF MAILING UNDER 37 CFR 1.8

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Dated: July 20, 2004

By:


Edith Martin

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Non-Final Office Action mailed May 5, 2004, please amend the above-identified application as follows:

Amendments to the claims are reflected in the listing of claims which begins on page 2 of this paper.

Remarks begin on page 11 of this paper.

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AMENDMENTS TO THE CLAIMS

This listing of claims will replace all prior versions, and listings, of claims in the application:

1. (original) A method of monitoring a container associated with an item, comprising:
receiving an indication that the container has been opened; and
arranging for ownership of the item to be transferred based on the indication.
2. (currently amended) The method of claim 1, wherein ownership is transferred to at least one of: (i) a person who opened the container, ~~and~~ or (ii) a party associated with the container.
3. (original) The method of claim 1, wherein said arranging comprises:
arranging for a party to provide payment in exchange for the item based on the indication.
4. (currently amended) The method of claim 3, wherein the payment is associated with at least one of: (i) a purchase, (ii) a license, (iii) a loan, ~~and~~ or (iv) a rental.
5. (original) The method of claim 1, wherein said receiving comprises:
receiving a signal generated by a remote transmitting device.
6. (original) The method of claim 5, wherein the transmitting device does not transmit a signal when the container is subsequently re-opened.

COPY

7. (currently amended) The method of claim 5, wherein the transmitting device is associated with at least one of: (i) a radio transmitter, (ii) a photosensitive device, (iii) a pressure sensitive device, (iv) a conductive element attached to an enclosure, (v) a seal having a conductive element, (vi) a seal having a non-conductive element, ~~and~~ or (vii) a flexible printed circuit board device.

8. (original) The method of claim 5, wherein said receiving comprises receiving the signal at a controller via a communication device.

9. (currently amended) The method of claim 1, wherein the indication includes at least one of: (i) a party identifier, (ii) an item identifier, (iii) an item category, (iv) a container identifier, (v) a date, (vi) a time, ~~and~~ or (vii) location information.

10. (currently amended) The method of claim 1, wherein the indication is received via at least one of: (i) a wireless network, (ii) an Internet protocol network, (iii) a Bluetooth network, ~~and~~ or (iv) a cellular network.

11. (original) The method of claim 1, further comprising:
providing the container to a party without receiving payment in exchange for the item.

12. (original) The method of claim 11, further comprising:
arranging for the party to provide security deposit information.

13. (currently amended) The method of claim 12, wherein the security deposit information comprises at least one of: (i) a credit card number, (ii) a debit card number, (iii) a bank account number, (iv) digital payment protocol information, ~~and~~ or (v) an address.

14. (currently amended) The method of claim 1, wherein the item comprises at least one of: (i) a consumer item, (ii) a consumable item, (iii) paper, (iv) toner, (v) energy, (vi) food, (vii) a medical item, (viii) medicine, (ix) disposable contact lenses, (x) a software program, (xi) an entertainment item, (xii) text information, (xiii) audio information, (xiv) image information, (xv) an information storage item, (xvi) a regulated item, ~~and~~ or (xvii) a financial item.

15. (currently amended) The method of claim 1, wherein the container comprises at least one of: (i) a package, (ii) a wrapper, (iii) a box, (iv) a bag, (v) a bottle, (vi) a can, (vii) an envelope, (viii) a label, (ix) a tag, ~~and~~ or (x) a tie.

16. (currently amended) A computer implemented method ~~of monitoring a disposable package containing a consumable item~~, comprising:

providing ~~the~~ a disposable package to a consumer without receiving payment in exchange for ~~the~~ a consumable item contained within the disposable package;

receiving an indication that the disposable package has been opened; and

arranging for the consumer to provide payment in exchange for the consumable item based on the indication.

17. (original) An apparatus, comprising:

a processor; and

a storage device in communication with said processor and storing instructions adapted to be executed by said processor to:

receive an indication that a container has been opened, and

arrange for ownership of an item associated with the container to be transferred based on the indication.

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18. (original) The apparatus of claim 17, wherein said storage device further stores a container status database.

19. (currently amended) The apparatus of claim 17, further comprising:
a communication device coupled to said processor and adapted to communicate with at least one of: (i) a container, (ii) a local device, (iii) a controller, ~~and~~ or (iv) a payment device.

20. (original) A medium storing instructions adapted to be executed by a processor to perform a method of monitoring a container associated with an item, said method comprising:
receiving an indication that the container has been opened; and
arranging for ownership of the item to be transferred based on the indication.

21. (original) A method of monitoring a remote container associated with an item, comprising:
receiving an indication that the container has been opened; and
arranging for another item to be provided based on the indication.

22. (currently amended) The method of claim 21, wherein said arranging comprises arranging for another item to be provided to at least one of: (i) a party associated with the container, (ii) an owner of the container, (iii) a person who opened the container, ~~and~~ or (iv) a destination associated with the container.

23. (original) The method of claim 22, wherein the party has access to a plurality of containers and said arranging is performed after a pre-determined number of indications are received.

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24. (original) The method of claim 21, further comprising:
determining a rate of usage based on the indication.

25. (currently amended) The method of claim 24, wherein the rate of usage is associated with at least one of: (i) a party associated with the container, (ii) an owner of the container, (iii) a person who opened the container, ~~and~~ or (iv) a destination associated with the container.

26. (original) The method of claim 24, further comprising:
reporting the rate of usage to a party associated with the container.

27. (currently amended) The method of claim 26, wherein said reporting is performed at least one of: (i) periodically, (ii) a single time, (iii) when the rate of usage is less than a minimum pre-determined threshold amount, ~~and~~ or (iv) when the rate of usage is more than a pre-determined maximum threshold amount.

28. (currently amended) The method of claim 21, wherein the indication comprises at least one of: (i) an indication of a number of containers that have been opened, ~~and~~ or (ii) an indication of a number of containers remaining.

29. (original) A method of monitoring a remote container associated with an item,
comprising:
receiving an indication that the container has been opened; and
determining item quality information based on the indication.

COPY

30. (original) The method of claim 29, wherein said determining is based on the date the indication was received.

31. (currently amended) The method of claim 30, wherein said determining is further based on a date associate with at least one of: (i) creation of the item, (ii) packaging of the item, (iii) sale of the item, ~~and~~ or (iv) delivery of the item.

32. (original) The method of claim 29, further comprising:
transmitting an indication of the item quality information.

33. (currently amended) The method of claim 32, wherein the indication of the item quality information is transmitted to at least one of: (i) a party associated with the container, (ii) an owner of the container, (iii) a person who opened the container, ~~and~~ or (iv) a destination associated with the container.

34. (currently amended) The method of claim 32, wherein the indication is transmitted at least one of: (i) periodically, (ii) a single time, ~~and~~ or (iii) when the item quality information is less than a pre-determined minimum item quality.

35. (original) A method of monitoring a remote container associated with an item, comprising:

receiving an indication that the container has been opened; and
determining item warranty information based on the indication.

36. (original) The method of claim 35, wherein the item warranty information comprises an effective date based on the date the container was opened by a consumer.

37. (original) The method of claim 35, wherein the warranty information is associated with a return policy.

38-41. canceled

42. (original) A method of monitoring a remote container associated with an item, comprising:

receiving an indication that the container has been opened; and
recording the indication as an acceptance of an agreement associated with the item.

43. (original) The method of claim 42, wherein the item is associated with a software program and the agreement comprises a license to use the software program.

44. (original) A method of monitoring a remote container associated with an item, comprising:

receiving a signal indicating that the container has been opened, the signal being generated by a transmitting device that does not transmit a signal when the container is subsequently re-opened; and

verifying that the container was opened in accordance with an item requirement.

45. (original) The method of claim 44, further comprising:

transmitting an alert if the container was not opened in accordance with the item requirement.

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46. (currently amended) The method of claim 45, wherein the alert is transmitted to at least one of: (i) a person who opened the container, (ii) a party associated with the item, ~~and~~ or (iii) a third party.

47. (original) The method of claim 44, wherein the item is associated with a medical treatment program.

48. (original) A container, comprising:

an enclosure; and

a transmitting device adapted to transmit a signal when the enclosure is opened, wherein the transmitting device does not transmit a signal when the enclosure is subsequently re-opened.

49. (currently amended) The container of claim 48, wherein the enclosure comprises at least one of: (i) a package, (ii) a wrapper, (iii) a box, (iv) a bag, (v) a bottle, (vi) a can, (vii) an envelope, (viii) a label, (ix) a tag, ~~and~~ or (x) a tie.

50. (currently amended) The container of claim 48, wherein the transmitting device is associated with at least one of: (i) radio transmitter, (ii) a photosensitive device, (iii) a pressure sensitive device, (iv) a conductive element attached to the enclosure, (v) a seal having a conductive element, (vi) a seal having a non-conductive element, (vii) a disposable transmitter, ~~and~~ or (viii) a flexible printed circuit board device.

51. (original) The container of claim 48, wherein the transmitting device does not transmit the signal if a pre-determined number of other containers are present.

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52. (new) A method, comprising:

arranging for an item owned by a first party to be within a container;

providing the container and the item to a second party without receiving payment for the item from the second party, wherein the first party remains the owner of the item while the second party has possession of the container and the item;

receiving a signal indicating that the container has been opened;

transferring ownership of the item to the second party in response to the signal; and

arranging for the second party to provide payment for the item in response to the signal.

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REMARKS

Upon entry of this amendment, claims 2, 4, 7, 9-10, 13-16, 19, 22, 25, 27-28, 31, 33, 34, 46 and 49-50 will be amended, claims 38-41 will be canceled, and claim 52 will be added. As a result, claims 1-37 and 42-52 will remain pending in the application. These amendments have been made solely to expedite prosecution of the present application, and Applicants reserve the right to pursue the subject matter of the original claims in this application and in other applications. No new matter has been added.

The pending claims stand rejected under 35 USC 102 and/or 103 as being unpatentable over US Patent No. 5,831,531 ("Tuttle") and/or various other references as described below. Applicants respectfully request reconsideration of these rejections in view of the following remarks.

The References Do Not Disclose or Suggest "Arranging for Ownership of [an] Item to be Transferred Based on [an] Indication" That a Container Has Been Opened

Claims 1-15 and 17-20 recite that an indication is received "that [a] container has been opened." Moreover, the claims recite "arranging for ownership of the item to be transferred based on the indication."

By way of example, a customer might take physical possession of a package that contains a printer toner cartridge (*e.g.*, he or she might bring the package home). Legal ownership of the printer toner cartridge, however, may remain with another party, such as a retailer or a manufacturer. When the customer eventually opens the package (*e.g.*, by opening a box or tearing a pouch), an indication may be transmitted. Based on the indication, it may be arranged for ownership of the item to be transferred to the customer.

Tuttle is directed to an anti-theft system to protect containers, such as suitcases. If a suitcase is opened (*e.g.*, by an unauthorized airport employee), a circuit in the suitcase is broken and a signal is transmitted. Based on the transmitted signal, an alarm is generated and/or appropriate security employees are alerted.

Nothing in Tuttle addresses a transfer of ownership of an item as recited in these claims.

According to the Office Action, this element is disclosed in FIG. 6A and at col. 4, lines 12-25. FIG. 6A is a picture of a suitcase handle. For convenience, col. 4, lines 12-25 are reproduced here:

FIG. 5 is a functional block diagram showing a method of communication between several RFID tags and an interrogation unit in light of the anti-theft detection units later described in FIGS. 6 and 7. Referring now to Figure 5, Host/CPU 51 interacts with interrogator/transceiver unit 52 and instructs unit 52 to interrogate RFID tags A (53) and B (54) for alarm data. If interrogator 52 receives no reply from either tag A or tag B the host 51 continues to instruct unit 52 to interrogate tags A and B as often as internal software demands it. However, if tag A responds (in an alarm state) the interrogator unit 52 communicates that information to the host 51 and an appropriate alarm is sounded to notify personnel that unauthorized opening of a container has just taken place.

That is, an alarm is generated when the suitcase is opened. The ownership of the suitcase, or of any items in the suitcase, is not transferred (either to security personnel or to the person who opened the suitcase without authorization).

Because Tuttle completely fails to disclose or suggest this feature, reconsideration of these rejections is respectfully requested.

The References Do Not Disclose or Suggest "Arranging for Another Item to be Provided Based on (an) Indication" That a Container Has Been Opened

Claims 21-28 recite "arranging for another item to be provided based on the indication." By way of example, when a customer eventually opens a package that contains a printer toner cartridge, a manufacturer might ship another package to the customer (e.g., via Federal Express).

Nothing in Tuttle addresses providing another item as recited in these claims.

According to the Office Action, this element is disclosed at col. 4, lines 18-21. For convenience, col. 4, lines 18-21 are reproduced here:

If interrogator 52 receives no reply from either tag A or tag B the host 51 continues to instruct unit 52 to interrogate tags A and B as often as internal software demands it.

That is, a periodic check is made to determine if the suitcase has been opened without authorization. Another suitcase is not provided to any party - nor is another item in any suitcase provided to any party. Applicants respectfully do not understand the rejection.

Because Tuttle completely fails to disclose or suggest this feature, reconsideration of these rejections is respectfully requested.

The References Do Not Disclose or Suggest Arranging for Another Item to be Provided
"After a Pre-Determined Number of Indications Are Received"

Claims 23 recites that it is arranged for another item to be provided "after a pre-determined number of indications are received." Consider, for example, a customer who purchases a thirty-day supply of disposable contact lenses. In this case, another thirty-day supply might be shipped to the customer after twenty indications have been received (because at that point the customer would only have a ten-day supply remaining).

Nothing in Tuttle addresses providing another item after a pre-determined number of indications are received as recited in this claim.

According to the Office Action, this element is disclosed at col. 4, lines 18-25. For convenience, col. 4, lines 18-21 are reproduced here:

If interrogator 52 receives no reply from either tag A or tag B the host 51 continues to instruct unit 52 to interrogate tags A and B as often as internal software demands it. However, if tag A responds (in an alarm state) the interrogator unit 52 communicates that information to the host 51 and an appropriate alarm is sounded to notify personnel that unauthorized opening of a container has just taken place.

That is, an alarm is generated when the suitcase is opened. No other item is provided to any party after a pre-determined number of indications have been received. For example, the alarm is not generated after a suitcase has been opened five times without authorization. Nor would such a feature make any sense in Tuttle.

Because Tuttle completely fails to disclose or suggest this feature, reconsideration of these rejections is respectfully requested.

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The References Do Not Disclose or Suggest a "Consumable Item" or a "Disposable Package"

Claim 16 recites a "consumable item" and a "disposable package." For example, copy paper might be provided in a wrapper. According to the Office Action, claim 16 stands rejected under 35 USC 103 as being unpatentable over Tuttle in view of Blomqvist. Moreover, according to the Office Action these elements were discussed with respect to claims 1 and 11. Applicants respectfully do not understand, and request allowance of claim 16.

The References Do Not Disclose or Suggest That a Signal is not Transmitted "If a Pre-Determined Number of Other Containers are Present"

Claim 51 recites that a signal indicating that a container has been opened is not transmitted "if a pre-determined number of other containers are present." For example, a customer might purchase ten reams of copy paper. As each ream is opened, a transmitter associated with that ream may determine how many other reams are present (e.g., via a short-distance wireless communication). When a ream determines that only two other reams are present, an indication may be provided (so that another ten-reams of paper can be shipped to the customer).

According to the Office Action, this element is described at col. 1, lines 54-57. For convenience, col. 1, lines 54-57 are reproduced here:

Simply, if continuity is disabled by a forced entry of the container, electrical detection means, such as a radio-frequency-identification (RFID) transceiver tag (or simply RFID tag), will alert the owner or monitoring station.

That is, an alarm is generated when the suitcase is opened. No determination is made as to how many other suitcases are in the area. Nor would such a feature make any sense in Tuttle.

Because Tuttle completely fails to disclose or suggest this feature, reconsideration of these rejections is respectfully requested.

COPY

The References Do Not Disclose or Suggest "Arranging for a Party to Provide Payment in Exchange for the Item Based on the Indication" or "Providing the Container to a Party Without Receiving Payment in Exchange for the Item"

Claims 3-4 recite "arranging for a party to provide payment in exchange for the item based on the indication." Claims 11-13 recite "providing the container to a party without receiving payment in exchange for the item." Claim 16 recites similar limitations.

By way of example, a customer might take physical possession of a package that contains a printer toner cartridge without providing payment to a retailer (*e.g.*, he or she might bring the package home). When the customer eventually opens the package, an indication may be transmitted. Based on the indication, it may be arranged for the customer to provide payment for the cartridge (*e.g.*, via his or her credit card number).

US Patent No. 5,859,415 ("Blomqvist") is directed to a system that wirelessly communicates with vehicles to arrange for the payment of tolls (*e.g.*, similar to an EZ-Pass system). Blomqvist also discloses the use of a debit card.

Applicants believe that neither Tuttle nor Blomqvist discloses or suggests arranging for a party to provide payment "in exchange for [an] item" ("item" is exchanged in either reference). Applicants also do not believe that either reference discloses arranging for a payment "based on [an] indication" that a container has been opened.

The teaching or suggestion to make the claimed combination must be found in the prior art, and not based on the Applicants' disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). The fact that references can potentially be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP 2143.01; In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH, 45 USPQ 2d 1977, 1981-82 (Fed. Cir. 1998) (the question to be asked is "whether the prior art contains a suggestion or motivation to combine references").

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As will be explained, there is no motivation in the prior art to modify or combine these references as proposed by the Examiner.

According to the Office Action, it would have been "obvious to one of ordinary skill in the art at the time the invention was made to employ the teaching of Blomqvist in the system of Tuttle because it would be more convenient to make a payment through wireless transmission of radiowaves." The advantages associated with arranging for payment after the customer has opened the container include, for example, increasing the number of items a customer might bring home at one time or receive in one shipment (*e.g.*, because he or she does not need to pay for the items until the container is opened) and reducing the amount of inventory that needs to be stored by a retailer. Neither reference is even remotely associated with these ideas.

If the suitcase disclosed in Tuttle is considered an "item" as recited in these claims, payment for the item would presumably be made when the airline customer purchased the suitcase. If transportation of the suitcase by an airline is considered an "item" as recited in these claims, payment for the item would presumably be made when the airline customer purchased his or her ticket. It simply would not make sense to modify Tuttle such that payment is made when a suitcase is opened without authorization.

Because there is no teaching or suggestion to modify the references in this way, a *prima facie* case of obviousness has not been established and the rejection of these claims should be withdrawn.

The References Do Not Disclose or Suggest That a Signal is Not Transmitted "When the Container is Subsequently Re-Opened"

Claim 6 recites that a signal generated by a remote transmitting device (*e.g.*, when a container is initially opened) is not transmitted "when the container is subsequently re-opened." Claims 44-51 includes similar limitations. By way of example, a signal might be transmitted when a customer initially opens a box that contains thirty-day supply contact lenses - but not when he or she re-opens the box the following day.

According to the Office Action, US Patent No. 6,507,275 ("Romano") discloses such an element at col. 4, lines 18-37. For convenience, col. 4, lines 18-37 are reproduced here:

Warning unit 26 is capable of generating an alert signal indicating when a medicament is to be taken. Warning unit 26 has an interface connector 31 which may be plugged into a plurality of conductors 32 on microprocessor 20. Additionally, warning unit 26 may also be connected to microprocessor 20 via a link between device connection port 33 and data link interface 25. In both respects, warning unit 26 will be able to communicate with microprocessor 20 and function in accordance with the data stored in microprocessor 20. Linking microprocessor 20 to warning unit 26 will produce a united device that possesses the combined functions and capabilities of both the microprocessor 20 and warning unit 26. Warning unit 26 could be used in nursing homes or other locations where a caregiver is available to a patient and may be alerted by the signal generated by warning unit 26. Upon being alerted, the caregiver can immediately attend to the patient and administer the appropriate medicament. The alert signal generated by the warning unit 26 can be a wireless transmission signal 35 sent to a mobile or stationary receiver or an audible alarm. Additionally, the warning unit could generate and send a signal to data output port 34, which could be wired to a stationary alerting unit located at the patient's bed or near the attending staff.

Applicants respectfully do not understand how this passage discloses that a signal is not transmitted when a "container is subsequently re-opened."

The References Do Not Disclose or Suggest "Determining Item Quality Information Based on [an] Indication" That a Container Has Been Opened

Claims 29-34 recite "determining item quality information based on" an indication that a container has been opened. For example, it might be determined that the quality of a roll of photographic film has degraded because a pouch that contains the roll was opened two months ago.

US Patent No. 5,798,694 ("Reber") is directed to a system that determines a food quality based on a sensor in a food container (*e.g.*, a thermometer) or based on how long the food container was removed from a refrigerator.

According to the Office Action, "it would have been obvious to the skilled artisan to use the teaching of Reber et al. in the system of Tuttle for monitoring the condition of the item which is an advantage."

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"That an inventor has probed the strengths and weaknesses of the prior art and discovered an improvement that escaped those who came before is indicative of unobviousness, not obviousness." Fromson v. Anitec Printing Plates, Inc., 45 USPQ 2d 1269, 1276 (Fed. Cir. 1997), cert. denied, 119 S. Ct. 56 (1998). By providing embodiments in which an item quality may be determined in accordance with when a container was opened, Applicants have addressed several problems of the prior art (e.g., to help ensure the quality of items that degrade after being opened). The mere fact that embodiments of the present invention provide an advantage does not make them unpatentable.

"[T]he suggestion to combine requirement is a safeguard against the use of hindsight combinations to negate patentability." In re Rouffet, 47 USPQ2d 1453 (Fed. Cir. 1998). The absence of any motivation in the prior art references to determine an item quality based on when a container was opened indicates that the Examiner has simply recognized a benefit provided by the present invention, and then used that benefit as a motivation to combine the references – the essence of impermissible hindsight reconstruction.

The References Do Not Disclose or Suggest "Determining Item Warranty Information Based on the Indication" or That the Warranty Information is Associated with "a Return Policy"

Claims 35- 37 recite "determining item warranty information" based on an indication that a container has been opened. Claim 37 further recites that the warranty information is associated with a "return policy." For example, a first party might purchase a box containing a television and give the box to a second party as a gift two months later. When the second party opens the box, an indication may be provided. As a result of the indication, warranty information might be determined at that time. For example, the second party may be allowed to return a defective television to a retailer within seven days after he or she opened the box.

According to the Office Action, Reber discloses such an element at col. 5, lines 33-38. For convenience, col. 5, lines 33-38 are reproduced here:

The second embodiment can be utilized to monitor for a discard condition of a food item when a temperature sensor is not included in the food storage apparatus 22. An alert indication can be generated if the time duration exceeds a predetermined time

duration. Using the aforementioned rule of the thumb, the predetermined time duration can be selected to be about 2 hours.

For example, it might be determined that a container of milk should be discarded if it has been outside of a refrigerator for more than two hours. Applicants respectfully do not understand how this passage discloses anything about "warranty information" or a "return policy."

The References Do Not Disclose or Suggest "Recording the Indication as an Acceptance of an Agreement Associated With the Item"

Claims 42-43 recite "recording [an] indication [that a container has been opened] as an acceptance of an agreement associated with the item." For example, a customer might purchase a Compact Disc (CD) that contains a computer program. The CD may be sealed in an envelope with a "Terms of Use Agreement" printed on an outside surface of the envelope. When he or she tears open the envelope, an indication may be generated and recorded as an acceptance of the Terms of Use Agreement by the customer.

As best understood by Applicants, US Patent No. 6,578,199 ("Tsou") discloses that software program usage may be monitored to determine whether or not an agreement is being violated (*e.g.*, an agreement to use the program on only a limited number of computers). Applicants respectfully suggest that the Office Action does not attempt to provide a motivation to combine Tuttle and Tsou (only that the combination would be "obvious"). Because there is no motivation to combine these references, Applicants respectfully request allowance of these claims.

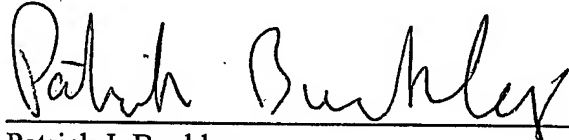
CONCLUSION

Claim 52 includes many of the limitations described herein. Applicants silence with respect to other statements made in the Office Action does not imply agreement with those statements.

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Applicants respectfully request allowance of the pending claims. If any issues remain, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is kindly invited to contact the undersigned via telephone at (203) 972-0191.

Respectfully submitted,



Patrick J. Buckley
Registration No. 40,928
Buckley, Maschoff & Talwalkar LLC
Five Elm Street
New Canaan, CT 06840
(203) 972-0191

July 20, 2004
Date

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Date: 07/20/2004
37 C.F.R. § 1.8

Title: **SYSTEMS, METHODS, AND APPARATUS FOR MONITORING A CONTAINER
ASSOCIATED WITH AN ITEM**

Inventors: Stern et al:

Enclosed herewith are:

- ☒ Amendment and Response to Non-Final Office Action.
☒ Response Transmittal.
☐ Other (specify): _____

IBM Docket No.: YOR920010483US1
Serial No.: 10/040,231
Filing Date: 01/02/2002

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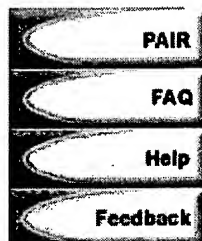
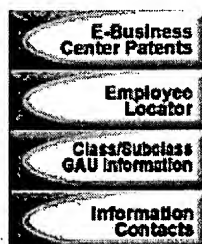
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Application Number:	10/040,231	Customer Number:	28062
Filing or 371(c) Date:	01-02-2002	Status:	Abandoned -- Failure to Respond to an Office Action
Application Type:	Utility	Status Date:	12-11-2004
Examiner Name:	NGUYEN, PHUNG	Location:	ELECTRONIC
Group Art Unit:	2632	Location Date:	-
Confirmation Number:	2900	Earliest Publication No:	US 2003-0122670 A1
Attorney Docket Number:	YOR920010483US1	Earliest Publication Date:	07-03-2003
Class/ Sub-Class:	340/568.1	Patent Number:	-
First Named Inventor:	Edith Stern, Yorktown Heights, NY (US)	Issue Date of Patent:	-
Title Of Invention:	Systems, methods, and apparatus for monitoring a container associated with an item		

Search Options

Assignments
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Image File Wrapper

File History	
Date	Contents Description
12-14-2004	Mail Abandonment for Failure to Respond to Office Action
12-11-2004	Abandonment for Failure to Respond to Office Action
07-22-2004	Workflow incoming amendment IFW
05-05-2004	Mail Non-Final Rejection
05-03-2004	Non-Final Rejection
04-05-2003	Case Docketed to Examiner in GAU
01-02-2002	Information Disclosure Statement (IDS) Filed
02-14-2002	Application Dispatched from OIPE
02-12-2002	Application Is Now Complete
02-04-2002	IFW Scan & PACR Auto Security Review
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REMARKS

Upon entry of this amendment, claims 2, 4, 7, 9-10, 13-16, 19, 22, 25, 27-28, 31, 33, 34, 46 and 49-50 will be amended, claims 38-41 will be canceled, and claim 52 will be added. As a result, claims 1-37 and 42-52 will remain pending in the application. These amendments have been made solely to expedite prosecution of the present application, and Applicants reserve the right to pursue the subject matter of the original claims in this application and in other applications. No new matter has been added.

The pending claims stand rejected under 35 USC 102 and/or 103 as being unpatentable over US Patent No. 5,831,531 ("Tuttle") and/or various other references as described below. Applicants respectfully request reconsideration of these rejections in view of the following remarks.

The References Do Not Disclose or Suggest "Arranging for Ownership of [an] Item to be Transferred Based on [an] Indication" That a Container Has Been Opened

Claims 1-15 and 17-20 recite that an indication is received "that [a] container has been opened." Moreover, the claims recite "arranging for ownership of the item to be transferred based on the indication."

By way of example, a customer might take physical possession of a package that contains a printer toner cartridge (e.g., he or she might bring the package home). Legal ownership of the printer toner cartridge, however, may remain with another party, such as a retailer or a manufacturer. When the customer eventually opens the package (e.g., by opening a box or tearing a pouch), an indication may be transmitted. Based on the indication, it may be arranged for ownership of the item to be transferred to the customer.

Tuttle is directed to an anti-theft system to protect containers, such as suitcases. If a suitcase is opened (e.g., by an unauthorized airport employee), a circuit in the suitcase is broken and a signal is transmitted. Based on the transmitted signal, an alarm is generated and/or appropriate security employees are alerted.

Nothing in Tuttle addresses a transfer of ownership of an item as recited in these claims.

According to the Office Action, this element is disclosed in FIG 6A and at col. 4, lines 12-25. FIG 6A is a picture of a suitcase handle. For convenience, col. 4, lines 12-25 are reproduced here:

FIG 5 is a functional block diagram showing a method of communication between several RFID tags and an interrogation unit in light of the anti-theft detection units later described in FIGS. 6 and 7. Referring now to Figure 5, Host/CPU 51 interacts with interrogator/transceiver unit 52 and instructs unit 52 to interrogate RFID tags A (53) and B (54) for alarm data. If interrogator 52 receives no reply from either tag A or tag B the host 51 continues to instruct unit 52 to interrogate tags A and B as often as internal software demands it. However, if tag A responds (in an alarm state) the interrogator unit 52 communicates that information to the host 51 and an appropriate alarm is sounded to notify personnel that unauthorized opening of a container has just taken place.

That is, an alarm is generated when the suitcase is opened. The ownership of the suitcase, or of any items in the suitcase, is not transferred (either to security personnel or to the person who opened the suitcase without authorization).

Because Tuttle completely fails to disclose or suggest this feature, reconsideration of these rejections is respectfully requested.

The References Do Not Disclose or Suggest "Arranging for Another Item to be Provided Based on (an) Indication" That a Container Has Been Opened

Claims 21-28 recite "arranging for another item to be provided based on the indication." By way of example, when a customer eventually opens a package that contains a printer toner cartridge, a manufacturer might ship another package to the customer (e.g., via Federal Express).

Nothing in Tuttle addresses providing another item as recited in these claims.

According to the Office Action, this element is disclosed at col. 4, lines 18-21. For convenience, col. 4, lines 18-21 are reproduced here:

If interrogator 52 receives no reply from either tag A or tag B the host 51 continues to instruct unit 52 to interrogate tags A and B as often as internal software demands it.

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That is, a periodic check is made to determine if the suitcase has been opened without authorization. Another suitcase is not provided to any party - nor is another item in any suitcase provided to any party. Applicants respectfully do not understand the rejection.

Because Tuttle completely fails to disclose or suggest this feature, reconsideration of these rejections is respectfully requested.

The References Do Not Disclose or Suggest Arranging for Another Item to be Provided
"After a Pre-Determined Number of Indications Are Received"

Claims 23 recites that it is arranged for another item to be provided "after a pre-determined number of indications are received." Consider, for example, a customer who purchases a thirty-day supply of disposable contact lenses. In this case, another thirty-day supply might be shipped to the customer after twenty indications have been received (because at that point the customer would only have a ten-day supply remaining).

Nothing in Tuttle addresses providing another item after a pre-determined number of indications are received as recited in this claim.

According to the Office Action, this element is disclosed at col. 4, lines 18-25. For convenience, col. 4, lines 18-21 are reproduced here:

If interrogator 52 receives no reply from either tag A or tag B the host 51 continues to instruct unit 52 to interrogate tags A and B as often as internal software demands it. However, if tag A responds (in an alarm state) the interrogator unit 52 communicates that information to the host 51 and an appropriate alarm is sounded to notify personnel that unauthorized opening of a container has just taken place.

That is, an alarm is generated when the suitcase is opened. No other item is provided to any party after a pre-determined number of indications have been received. For example, the alarm is not generated after a suitcase has been opened five times without authorization. Nor would such a feature make any sense in Tuttle.

Because Tuttle completely fails to disclose or suggest this feature, reconsideration of these rejections is respectfully requested.

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The References Do Not Disclose or Suggest a "Consumable Item" or a "Disposable Package"

Claim 16 recites a "consumable item" and a "disposable package." For example, copy paper might be provided in a wrapper. According to the Office Action, claim 16 stands rejected under 35 USC 103 as being unpatentable over Tuttle in view of Blomqvist. Moreover, according to the Office Action these elements were discussed with respect to claims 1 and 11. Applicants respectfully do not understand, and request allowance of claim 16.

The References Do Not Disclose or Suggest That a Signal is not Transmitted "If a Pre-Determined Number of Other Containers are Present"

Claim 51 recites that a signal indicating that a container has been opened is not transmitted "if a pre-determined number of other containers are present." For example, a customer might purchase ten reams of copy paper. As each ream is opened, a transmitter associated with that ream may determine how many other reams are present (*e.g.*, via a short-distance wireless communication). When a ream determines that only two other reams are present, an indication may be provided (so that another ten-reams of paper can be shipped to the customer).

According to the Office Action, this element is described at col. 1, lines 54-57. For convenience, col. 1, lines 54-57 are reproduced here:

Simply, if continuity is disabled by a forced entry of the container, electrical detection means, such as a radio-frequency-identification (RFID) transceiver tag (or simply RFID tag), will alert the owner or monitoring station.

That is, an alarm is generated when the suitcase is opened. No determination is made as to how many other suitcases are in the area. Nor would such a feature make any sense in Tuttle.

Because Tuttle completely fails to disclose or suggest this feature, reconsideration of these rejections is respectfully requested.

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The References Do Not Disclose or Suggest "Arranging for a Party to Provide Payment in Exchange for the Item Based on the Indication" or "Providing the Container to a Party Without Receiving Payment in Exchange for the Item"

Claims 3-4 recite "arranging for a party to provide payment in exchange for the item based on the indication." Claims 11-13 recite "providing the container to a party without receiving payment in exchange for the item." Claim 16 recites similar limitations.

By way of example, a customer might take physical possession of a package that contains a printer toner cartridge without providing payment to a retailer (*e.g.*, he or she might bring the package home). When the customer eventually opens the package, an indication may be transmitted. Based on the indication, it may be arranged for the customer to provide payment for the cartridge (*e.g.*, via his or her credit card number).

US Patent No. 5,859,415 ("Blomqvist") is directed to a system that wirelessly communicates with vehicles to arrange for the payment of tolls (*e.g.*, similar to an EZ-Pass system). Blomqvist also discloses the use of a debit card.

Applicants believe that neither Tuttle nor Blomqvist discloses or suggests arranging for a party to provide payment "in exchange for [an] item" ("item" is exchanged in either reference). Applicants also do not believe that either reference discloses arranging for a payment "based on [an] indication" that a container has been opened.

The teaching or suggestion to make the claimed combination must be found in the prior art, and not based on the Applicants' disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). The fact that references can potentially be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP 2143.01; In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH, 45 USPQ 2d 1977, 1981-82 (Fed. Cir. 1998) (the question to be asked is "whether the prior art contains a suggestion or motivation to combine references").

As will be explained, there is no motivation in the prior art to modify or combine these references as proposed by the Examiner.

According to the Office Action, it would have been "obvious to one of ordinary skill in the art at the time the invention was made to employ the teaching of Blomqvist in the system of Tuttle because it would be more convenient to make a payment through wireless transmission of radiowaves." The advantages associated with arranging for payment after the customer has opened the container include, for example, increasing the number of items a customer might bring home at one time or receive in one shipment (*e.g.*, because he or she does not need to pay for the items until the container is opened) and reducing the amount of inventory that needs to be stored by a retailer. Neither reference is even remotely associated with these ideas.

If the suitcase disclosed in Tuttle is considered an "item" as recited in these claims, payment for the item would presumably be made when the airline customer purchased the suitcase. If transportation of the suitcase by an airline is considered an "item" as recited in these claims, payment for the item would presumably be made when the airline customer purchased his or her ticket. It simply would not make sense to modify Tuttle such that payment is made when a suitcase is opened without authorization.

Because there is no teaching or suggestion to modify the references in this way, a *prima facie* case of obviousness has not been established and the rejection of these claims should be withdrawn.

The References Do Not Disclose or Suggest That a Signal is Not Transmitted "When the Container is Subsequently Re-Opened"

Claim 6 recites that a signal generated by a remote transmitting device (*e.g.*, when a container is initially opened) is not transmitted "when the container is subsequently re-opened." Claims 44-51 includes similar limitations. By way of example, a signal might be transmitted when a customer initially opens a box that contains thirty-day supply contact lenses - but not when he or she re-opens the box the following day.

According to the Office Action, US Patent No. 6,507,275 ("Romano") discloses such an element at col. 4, lines 18-37. For convenience, col. 4, lines 18-37 are reproduced here:

Warning unit 26 is capable of generating an alert signal indicating when a medicament is to be taken. Warning unit 26 has an interface connector 31 which may be plugged into a plurality of conductors 32 on microprocessor 20. Additionally, warning unit 26 may also be connected to microprocessor 20 via a link between device connection port 33 and data link interface 25. In both respects, warning unit 26 will be able to communicate with microprocessor 20 and function in accordance with the data stored in microprocessor 20. Linking microprocessor 20 to warning unit 26 will produce a united device that possesses the combined functions and capabilities of both the microprocessor 20 and warning unit 26. Warning unit 26 could be used in nursing homes or other locations where a caregiver is available to a patient and may be alerted by the signal generated by warning unit 26. Upon being alerted, the caregiver can immediately attend to the patient and administer the appropriate medicament. The alert signal generated by the warning unit 26 can be a wireless transmission signal 35 sent to a mobile or stationary receiver or an audible alarm. Additionally, the warning unit could generate and send a signal to data output port 34, which could be wired to a stationary alerting unit located at the patient's bed or near the attending staff.

Applicants respectfully do not understand how this passage discloses that a signal is not transmitted when a "container is subsequently re-opened."

The References Do Not Disclose or Suggest "Determining Item Quality Information Based on [an] Indication" That a Container Has Been Opened

Claims 29-34 recite "determining item quality information based on" an indication that a container has been opened. For example, it might be determined that the quality of a roll of photographic film has degraded because a pouch that contains the roll was opened two months ago.

US Patent No. 5,798,694 ("Reber") is directed to a system that determines a food quality based on a sensor in a food container (*e.g.*, a thermometer) or based on how long the food container was removed from a refrigerator.

According to the Office Action, "it would have been obvious to the skilled artisan to use the teaching of Reber et al. in the system of Tuttle for monitoring the condition of the item which is an advantage."

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"That an inventor has probed the strengths and weaknesses of the prior art and discovered an improvement that escaped those who came before is indicative of unobviousness, not obviousness." Fromson v. Anitec Printing Plates, Inc., 45 USPQ 2d 1269, 1276 (Fed. Cir. 1997), cert. denied, 119 S. Ct. 56 (1998). By providing embodiments in which an item quality may be determined in accordance with when a container was opened, Applicants have addressed several problems of the prior art (e.g., to help ensure the quality of items that degrade after being opened). The mere fact that embodiments of the present invention provide an advantage does not make them unpatentable.

"[T]he suggestion to combine requirement is a safeguard against the use of hindsight combinations to negate patentability." In re Rouffet, 47 USPQ2d 1453 (Fed. Cir. 1998). The absence of any motivation in the prior art references to determine an item quality based on when a container was opened indicates that the Examiner has simply recognized a benefit provided by the present invention, and then used that benefit as a motivation to combine the references – the essence of impermissible hindsight reconstruction.

The References Do Not Disclose or Suggest "Determining Item Warranty Information Based on the Indication" or That the Warranty Information is Associated with "a Return Policy"

Claims 35- 37 recite "determining item warranty information" based on an indication that a container has been opened. Claim 37 further recites that the warranty information is associated with a "return policy." For example, a first party might purchase a box containing a television and give the box to a second party as a gift two months later. When the second party opens the box, an indication may be provided. As a result of the indication, warranty information might be determined at that time. For example, the second party may be allowed to return a defective television to a retailer within seven days after he or she opened the box.

According to the Office Action, Reber discloses such an element at col. 5, lines 33-38. For convenience, col. 5, lines 33-38 are reproduced here:

The second embodiment can be utilized to monitor for a discard condition of a food item when a temperature sensor is not included in the food storage apparatus 22. An alert indication can be generated if the time duration exceeds a predetermined time

duration. Using the aforementioned rule of the thumb, the predetermined time duration can be selected to be about 2 hours.

For example, it might be determined that a container of milk should be discarded if it has been outside of a refrigerator for more than two hours. Applicants respectfully do not understand how this passage discloses anything about "warranty information" or a "return policy."

The References Do Not Disclose or Suggest "Recording the Indication as an Acceptance of an Agreement Associated With the Item"

Claims 42-43 recite "recording [an] indication [that a container has been opened] as an acceptance of an agreement associated with the item." For example, a customer might purchase a Compact Disc (CD) that contains a computer program. The CD may be sealed in an envelope with a "Terms of Use Agreement" printed on an outside surface of the envelope. When he or she tears open the envelope, an indication may be generated and recorded as an acceptance of the Terms of Use Agreement by the customer.

As best understood by Applicants, US Patent No. 6,578,199 ("Tsou") discloses that software program usage may be monitored to determine whether or not an agreement is being violated (e.g., an agreement to use the program on only a limited number of computers). Applicants respectfully suggest that the Office Action does not attempt to provide a motivation to combine Tuttle and Tsou (only that the combination would be "obvious"). Because there is no motivation to combine these references, Applicants respectfully request allowance of these claims.

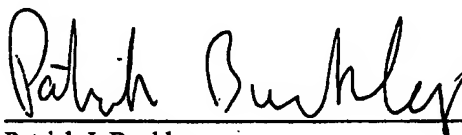
CONCLUSION

Claim 52 includes many of the limitations described herein. Applicants' silence with respect to other statements made in the Office Action does not imply agreement with those statements.

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Applicants respectfully request allowance of the pending claims. If any issues remain, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is kindly invited to contact the undersigned via telephone at (203) 972-0191.

Respectfully submitted,

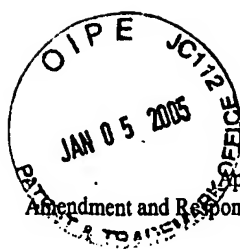


July 20, 2004

Date

Patrick J. Buckley
Registration No. 40,928
Buckley, Maschoff & Talwalkar LLC
Five Elm Street
New Canaan, CT 06840
(203) 972-0191

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Application Serial No.: 10/040,231
Amendment and Response to May 5, 2004 Office Action

AMENDMENTS TO THE CLAIMS

This listing of claims will replace all prior versions, and listings, of claims in the application:

1. (original) A method of monitoring a container associated with an item, comprising:
receiving an indication that the container has been opened; and
arranging for ownership of the item to be transferred based on the indication.
2. (currently amended) The method of claim 1, wherein ownership is transferred to at least one of: (i) a person who opened the container, ~~and~~ or (ii) a party associated with the container.
3. (original) The method of claim 1, wherein said arranging comprises:
arranging for a party to provide payment in exchange for the item based on the indication.
4. (currently amended) The method of claim 3, wherein the payment is associated with at least one of: (i) a purchase, (ii) a license, (iii) a loan, ~~and~~ or (iv) a rental.
5. (original) The method of claim 1, wherein said receiving comprises:
receiving a signal generated by a remote transmitting device.
6. (original) The method of claim 5, wherein the transmitting device does not transmit a signal when the container is subsequently re-opened.

7. (currently amended) The method of claim 5, wherein the transmitting device is associated with at least one of: (i) a radio transmitter, (ii) a photosensitive device, (iii) a pressure sensitive device, (iv) a conductive element attached to an enclosure, (v) a seal having a conductive element, (vi) a seal having a non-conductive element, ~~and~~ or (vii) a flexible printed circuit board device.

8. (original) The method of claim 5, wherein said receiving comprises receiving the signal at a controller via a communication device.

9. (currently amended) The method of claim 1, wherein the indication includes at least one of: (i) a party identifier, (ii) an item identifier, (iii) an item category, (iv) a container identifier, (v) a date, (vi) a time, ~~and~~ or (vii) location information.

10. (currently amended) The method of claim 1, wherein the indication is received via at least one of: (i) a wireless network, (ii) an Internet protocol network, (iii) a Bluetooth network, ~~and~~ or (iv) a cellular network.

11. (original) The method of claim 1, further comprising:
providing the container to a party without receiving payment in exchange for the item.

12. (original) The method of claim 11, further comprising:
arranging for the party to provide security deposit information.

13. (currently amended) The method of claim 12, wherein the security deposit information comprises at least one of: (i) a credit card number, (ii) a debit card number, (iii) a bank account number, (iv) digital payment protocol information, ~~and~~ or (v) an address.

14. (currently amended) The method of claim 1, wherein the item comprises at least one of: (i) a consumer item, (ii) a consumable item, (iii) paper, (iv) toner, (v) energy, (vi) food, (vii) a medical item, (viii) medicine, (ix) disposable contact lenses, (x) a software program, (xi) an entertainment item, (xii) text information, (xiii) audio information, (xiv) image information, (xv) an information storage item, (xvi) a regulated item, ~~and~~ or (xvii) a financial item.

15. (currently amended) The method of claim 1, wherein the container comprises at least one of: (i) a package, (ii) a wrapper, (iii) a box, (iv) a bag, (v) a bottle, (vi) a can, (vii) an envelope, (viii) a label, (ix) a tag, ~~and~~ or (x) a tie.

16. (currently amended) A computer implemented method ~~of monitoring a disposable package containing a consumable item~~, comprising:

providing ~~the~~ a disposable package to a consumer without receiving payment in exchange for ~~the~~ a consumable item contained within the disposable package;

receiving an indication that the disposable package has been opened; and

arranging for the consumer to provide payment in exchange for the consumable item based on the indication.

17. (original) An apparatus, comprising:

a processor; and

a storage device in communication with said processor and storing instructions adapted to be executed by said processor to:

receive an indication that a container has been opened, and

arrange for ownership of an item associated with the container to be transferred based on the indication.

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18. (original) The apparatus of claim 17, wherein said storage device further stores a container status database.

19. (currently amended) The apparatus of claim 17, further comprising:

a communication device coupled to said processor and adapted to communicate with at least one of: (i) a container, (ii) a local device, (iii) a controller, ~~and~~ or (iv) a payment device.

20. (original) A medium storing instructions adapted to be executed by a processor to perform a method of monitoring a container associated with an item, said method comprising:

receiving an indication that the container has been opened; and

arranging for ownership of the item to be transferred based on the indication.

21. (original) A method of monitoring a remote container associated with an item, comprising:

receiving an indication that the container has been opened; and

arranging for another item to be provided based on the indication.

22. (currently amended) The method of claim 21, wherein said arranging comprises arranging for another item to be provided to at least one of: (i) a party associated with the container, (ii) an owner of the container, (iii) a person who opened the container, ~~and~~ or (iv) a destination associated with the container.

23. (original) The method of claim 22, wherein the party has access to a plurality of containers and said arranging is performed after a pre-determined number of indications are received.

24. (original) The method of claim 21, further comprising:

determining a rate of usage based on the indication.

25. (currently amended) The method of claim 24, wherein the rate of usage is associated with at least one of: (i) a party associated with the container, (ii) an owner of the container, (iii) a person who opened the container, ~~and~~ or (iv) a destination associated with the container.

26. (original) The method of claim 24, further comprising:

reporting the rate of usage to a party associated with the container.

27. (currently amended) The method of claim 26, wherein said reporting is performed at least one of: (i) periodically, (ii) a single time, (iii) when the rate of usage is less than a minimum pre-determined threshold amount, ~~and~~ or (iv) when the rate of usage is more than a pre-determined maximum threshold amount.

28. (currently amended) The method of claim 21, wherein the indication comprises at least one of: (i) an indication of a number of containers that have been opened, ~~and~~ or (ii) an indication of a number of containers remaining.

29. (original) A method of monitoring a remote container associated with an item, comprising:

receiving an indication that the container has been opened; and

determining item quality information based on the indication.

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30. (original) The method of claim 29, wherein said determining is based on the date the indication was received.

31. (currently amended) The method of claim 30, wherein said determining is further based on a date associate with at least one of: (i) creation of the item, (ii) packaging of the item, (iii) sale of the item, ~~and~~ or (iv) delivery of the item.

32. (original) The method of claim 29, further comprising:
transmitting an indication of the item quality information.

33. (currently amended) The method of claim 32, wherein the indication of the item quality information is transmitted to at least one of: (i) a party associated with the container, (ii) an owner of the container, (iii) a person who opened the container, ~~and~~ or (iv) a destination associated with the container.

34. (currently amended) The method of claim 32, wherein the indication is transmitted at least one of: (i) periodically, (ii) a single time, ~~and~~ or (iii) when the item quality information is less than a pre-determined minimum item quality.

35. (original) A method of monitoring a remote container associated with an item, comprising:

receiving an indication that the container has been opened; and
determining item warranty information based on the indication.

36. (original) The method of claim 35, wherein the item warranty information comprises an effective date based on the date the container was opened by a consumer.

37. (original) The method of claim 35, wherein the warranty information is associated with a return policy.

38-41. canceled

42. (original) A method of monitoring a remote container associated with an item, comprising:

receiving an indication that the container has been opened; and

recording the indication as an acceptance of an agreement associated with the item.

43. (original) The method of claim 42, wherein the item is associated with a software program and the agreement comprises a license to use the software program.

44. (original) A method of monitoring a remote container associated with an item, comprising:

receiving a signal indicating that the container has been opened, the signal being generated by a transmitting device that does not transmit a signal when the container is subsequently re-opened; and

verifying that the container was opened in accordance with an item requirement.

45. (original) The method of claim 44, further comprising:

transmitting an alert if the container was not opened in accordance with the item requirement.

46. (currently amended) The method of claim 45, wherein the alert is transmitted to at least one of: (i) a person who opened the container, (ii) a party associated with the item, ~~and~~ or (iii) a third party.

47. (original) The method of claim 44, wherein the item is associated with a medical treatment program.

48. (original) A container, comprising:

an enclosure; and

a transmitting device adapted to transmit a signal when the enclosure is opened, wherein the transmitting device does not transmit a signal when the enclosure is subsequently re-opened.

49. (currently amended) The container of claim 48, wherein the enclosure comprises at least one of: (i) a package, (ii) a wrapper, (iii) a box, (iv) a bag, (v) a bottle, (vi) a can, (vii) an envelope, (viii) a label, (ix) a tag, ~~and~~ or (x) a tie.

50. (currently amended) The container of claim 48, wherein the transmitting device is associated with at least one of: (i) radio transmitter, (ii) a photosensitive device, (iii) a pressure sensitive device, (iv) a conductive element attached to the enclosure, (v) a seal having a conductive element, (vi) a seal having a non-conductive element, (vii) a disposable transmitter, ~~and~~ or (viii) a flexible printed circuit board device.

51. (original) The container of claim 48, wherein the transmitting device does not transmit the signal if a pre-determined number of other containers are present.

52. (new) A method, comprising:

arranging for an item owned by a first party to be within a container;

providing the container and the item to a second party without receiving payment for the item from the second party, wherein the first party remains the owner of the item while the second party has possession of the container and the item;

receiving a signal indicating that the container has been opened;

transferring ownership of the item to the second party in response to the signal; and

arranging for the second party to provide payment for the item in response to the signal.

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Application Serial No.: 10/040,231
Amendment and Response to May 5, 2004 Office Action

Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: STERN et al.

Application Serial No.: 10/040,231

Filing Date: January 2, 2002

For: SYSTEMS, METHODS, AND
APPARATUS FOR MONITORING
A CONTAINER ASSOCIATED
WITH AN ITEM

)
) Group Art Unit: 2632
)
) Examiner: Nguyen, Phung
)
) **AMENDMENT and RESPONSE** to May
) 5, 2004 Non-Final Office Action
)
) **IBM Docket No.: YOR920010483US1**
) (Attorney Docket No.: 101.060)
)
) Buckley, Maschoff & Talwalkar LLC
) Five Elm Street
) New Canaan, CT 06840
) (203) 972-0006
)

CERTIFICATE OF MAILING UNDER 37 CFR 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on July 20, 2004.

Dated: July 20, 2004

By: 

Edith Martin

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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JUL 23 2004

Technology Center 2600

Sir:

In response to the Non-Final Office Action mailed May 5, 2004, please amend the above-identified application as follows:

Amendments to the claims are reflected in the listing of claims which begins on page 2 of this paper.

Remarks begin on page 11 of this paper.

COPY

41 2632



Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: STERN et al.

Application Serial No.: 10/040,231

Filing Date: January 2, 2002

For: SYSTEMS, METHODS, AND
APPARATUS FOR MONITORING
A CONTAINER ASSOCIATED
WITH AN ITEM

)
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) Group Art Unit: 2632
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) Examiner: Nguyen, Phung
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) Response Transmittal
)
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) (Attorney Docket No.: I01.060)
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) Buckley, Maschoff & Talwalkar LLC
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Edith Martin
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P.O. Box 1450
Alexandria, VA 22313-1450

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Sir:

Transmitted herewith for filing are:

1. ☒ Amendment/Response
2. ☒ Additional Enclosures: Acknowledgement Postcard

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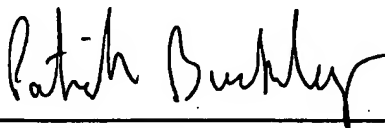
FEE CALCULATION

For	Current	Prev. Paid	No. Extra	Rate	Fee
Total Claims	47	- 51	0	\$ 18.00	\$ 0.00
Indep. Claims	10	- 12	0	\$ 86.00	\$ 0.00
Multiple Dependent Claims (If applicable, please add \$ 290.00)					\$ 0.00
No Petition for Extension of Time is Required					\$ 0.00
OTHER FEE (specify purpose):					\$ 0.00
TOTAL FILING FEE					\$ 0.00

The Commissioner is hereby authorized to charge and credit Deposit Account No. 50-0510 as described below. A duplicate copy of this sheet is enclosed.

- ☒ Credit any overpayment.
- ☒ Charge any additional fees required under 37 CFR 1.17.

Respectfully submitted,



Patrick J. Buckley
 Registration No. 40,928
 Attorney for IBM Corporation
 Buckley, Maschoff & Talwalkar LLC
 Five Elm Street
 New Canaan, CT 06840
 (203) 972-0191

July 20, 2004
 Date

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